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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/615,571	07/13/2000	Paul Harris	5951.010-US	4949
25907	7590	01/13/2004	EXAMINER	
NOVOZYMES BIOTECH, INC.			PRIEBE, SCOTT DAVID	
1445 DREW AVE			ART UNIT	
DAVIS, CA 95616			PAPER NUMBER	

1632

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/615,571

Applicant(s)

HARRIS ET AL.

Examiner

Scott D. Priebe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003 and 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 100, 102-107, 109-112, 114-117 and 119-128 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 125-128 is/are allowed.
- 6) ☒ Claim(s) 100, 102-104, 109-111, 114, 115, 117, 119-124 is/are rejected.
- 7) ☒ Claim(s) 105-107, 112 and 116 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10/6/03 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 100, 102-104, 109-111, 114-115, and 120-124 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons of record applied to claims 71-75, 79-82, 84-86, and 91-95, respectively, in the Office action of 12/7/01.

Applicant's arguments filed 10/6/03 have been fully considered but they are not persuasive. Applicant repeats the argument made in the amendment filed 2/6/03 that one would expect that the claimed polynucleotides would code for proteins with similar function. This argument has already been addressed in the Advisory Action of 7/14/03. While one might expect

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this to be true for naturally occurring polynucleotides, the claims are not limited to naturally occurring polynucleotides, nor has the specification described any such natural polynucleotides other than SEQ ID NO: 1. The Office had provided evidence and sound scientific and legal reasoning in support of the rejection. It is now Applicant's burden to overcome the rejection. It is not the burden of the Office to disprove unsupported assertions made by Applicant. Applicant is reminded that "Argument of counsel cannot take the place of evidence lacking in the record" (*In re Scarbrough*, 182 USPQ 298, 302 (CCPA 1974)).

Claims 100, 102-104, 109-111, 114-115, 117 and 119-124 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid sequence encoding a phospholipase B wherein either the nucleic acid sequence comprises nucleotides 568 to 2045 of SEQ ID NO: 1 or the polypeptide comprises amino acids 20-464 of SEQ ID NO: 2, does not reasonably provide enablement for any other embodiments lying outside this scope. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims for the reasons of record applied to claims 71-75, 79-82, 84-86, and 88-95, respectively, in the Office action of 12/7/01.

Applicant's arguments filed 10/6/03 have been fully considered but they are not persuasive. Applicant argues that page 9, line 7, to page 10, line 30, discloses species of organisms that "could provide" a source for the claimed nucleic acids. In response, this section of the specification deals with "polypeptides of the invention" --not nucleic acids, and which are described on page 8, lines 28-31, as being at least 20% identical to SEQ ID NO: 2. The scope of

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"polypeptides of the invention" is far broader than the polypeptides encoded by the claimed polynucleotides. Furthermore, the claims are not limited to polynucleotides found in or copied from nature, the claims also embrace man-made variants.

Allowable Subject Matter

Claims 125-128 remain allowed.

Claims 105-107, 112, and 116 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

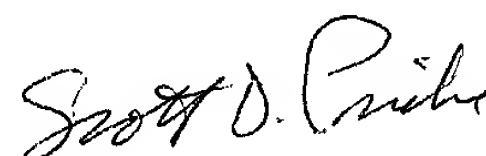
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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310 (after 1/12/04 - (571) 272-0733). The examiner can normally be reached on M-F, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds can be reached on (703) 305-4051. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Scott D. Priebe
Primary Examiner
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